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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/528,964

03/18/2005

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SHI-003FORus

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EXAMINER

JOY, DAVID J

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

09/17/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/528,964	<b>Applicant(s)</b> COPLAND ET AL.	
	<b>Examiner</b> David J. Joy	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 7-25 is/are pending in the application.
- 4a) Of the above claim(s) 1 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-22, 24 and 25 is/are rejected.
- 7) ☒ Claim(s) 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1 and 7-25 are pending as amended on September 8, 2008. Claim 1 is currently withdrawn from consideration.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Continued Examination Under 37 CFR 1.114***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 8, 2008 has been entered.

### ***Response to Amendments***

4. Applicant's amendments to Claims 1 and 12, filed September 8, 2008, with respect to correcting the typographical errors ("beem applied" in Claim 1) and properly

delineating the amended portions of the claim (in Claim 12) have been considered and are corrective. As such, the objections to the claims have been withdrawn.

5. Applicant's amendments to Claim 7, filed September 8, 2008, obviates the previously cited rejections under 35 U.S.C. §112. The rejection of Claims 7-25 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement, has been withdrawn. Likewise, the rejection of Claims 7-25 under 35 U.S.C. §112, second paragraph, as being indefinite, has been withdrawn.

6. Applicant's amendment to Claim 7, filed September 8, 2008, obviates the previously cited rejections under 35 U.S.C. §§ 102 and 103. The rejection of Claims 7-9, 11-21 and 23 under 35 U.S.C. §102(e), as being anticipated by the U.S. Patent Application Publication of Godbey et al. (2002/0187181; hereinafter "Godbey"), has been withdrawn. The rejection of Claims 10 and 22 under 35 U.S.C. §103(a), as being unpatentable over Godbey in view of either Applicant's admissions or the U.S. Patent Application Publication of Dole et al. (2003/044366; hereinafter "Dole"), has been withdrawn.

***Claim Objections***

7. Claim 15 is objected to because of the following informalities: There appears to be a typographical error in the second line of the claim, where it recites “compresses sugars” (instead of *compressed* sugars). Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

8. Claims 9, 11, 16, 17, 24 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. It is unclear how some of the species for the surfactant recited in Claim 9 function as surfactants (for example, though there are others, how are enzymes and/or anti-oxidants properly listed as types of surfactants?).

10. As for Claim 11, the phrase “vegetable based printing ink” is indefinite. A review of the specification turned up a teaching of a *vegetable oil based ink*, but it is unclear what is meant by a vegetable based ink.

11. With regard to Claim 16, in Line 2 of the claim, the use of the adjective “substantial” in describing the quantity of surfactant that is absorbed and retained renders the claim indefinite, since it is not clear what particular quantity, or threshold amount, of surfactant would qualify as being a *substantial* quantity.
12. Further, in Claim 17, the recitation of the term “sponge-like” in describing a synthetic composition is indefinite, as it cannot readily be determined what types of materials would qualify as being *sponge-like*.
13. Finally, Claim 24 states that "the image is covered by a coating" that is "effective for controlling the disappearance time of the image", and Claim 24 depends upon Claim 7. However, Claim 7 states the limitation that the surfactant is place along the surface of the substrate, and that the surfactant covers at least a portion of the image. As a result, it is unclear, and therefore it is indefinite, as to whether the disappearance controlling coating is applied to the image, before the surfactant is applied thereon, or whether the coating covers the surfactant, or whether the surfactant and the coating are non-continuous and can be applied as parallel coatings that each cover a portion of the image, without there being any overlap between the two. Claim 25 is rejected accordingly, as it depends upon Claim 24.

***Claim Rejections - 35 USC § 102***

14. Claims 7-22 are rejected under 35 U.S.C. 102(e) as being anticipated by the U.S. Patent Application Publication of Forest et al. (2002/0022008; hereinafter "Forest").

15. Forest teaches an article for applying and monitoring a surfactant ("sun protection kit") that comprises a substrate ("carrier") having an image ("indicator") applied to the surface of the substrate, and a surfactant ("sunscreen") placed along the surface of the substrate, such that the surfactant covers a portion of the image (see Abstract; see also ¶¶ [0002], [0014], [0015], [0048], [0060] and [0061]). Forest also teaches that the image indicates the continuing effectiveness of the surfactant (see Abstract; see also ¶¶ [0002], [0008], [0019] and [0061]). Additionally, Forest provides that the surfactant is an epidermal surfactant, given that the surfactant is a sunscreen, but also that the surfactant can comprise a mixture that further includes dyes (which could be used as artificial tanning agents), fragrances, antimicrobial agents, and other additives (see ¶¶ [0041], [0048] and [0050]-[0051]). Forest also provides that the image/indicator is a photochromic ink, and that the diluents that are present include such solvents as castor oil, which reads upon the limitation of a vegetable based printing ink (see ¶¶ [0052] and [0129]-[0131]). Further, Forest teaches that the image/indicator can be a decal

or a coating, and that that image can be a material that dissolves in water, such as polymers, gelatin (i.e., proteins), starches, pectin, etc. (see ¶¶ [0060]-[0062] and [0118]-[0119]).

16. Forest teaches that the substrate is a non-woven material (i.e., it expressly provides that the carrier is a skin-like medium), that the substrate can absorb/retain a quantity of the surfactant, and that the substrate can also be a material that dissolves in water, such as polymers, gelatin (i.e., proteins), starches, pectin, etc. (see ¶¶ [0033], [0056], [0112] and [0118]-[0119]). Also, Forest provides that the article includes a way to secure the article to one's skin (see ¶¶ [0047], [0060] and [0112]). In addition, Forest teaches that the image is such that it can disappear as the surfactant dissipates, that it can start out as being transparent and then become visible as the surfactant dissipates, and/or that the image can change color as the surfactant dissipates (see ¶ [0055]).

### ***Response to Arguments***

17. Applicant's arguments with respect to Claims 7-25 have been considered but are moot in view of the new grounds of rejection.



*Allowable Subject Matter*

18. Claim 23 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The reason for indicating these claims as being allowable but objected to is that Forest fails to teach or fairly suggest that the substrate has a first surfactant on a first surface thereof and a second surfactant on a second surface thereof.

*Conclusion*

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Joy whose telephone number is (571)272-9056.

The examiner can normally be reached on Monday - Friday, 7:00 AM - 3:30 PM EST.

20. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie E. Shosho can be reached on (571) 272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DJJ/

Examiner, Art Unit 1794

09/11/2008

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1794